

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-15 and 17-28 are now present in this application. Claims 1 and 20-23 are independent.

By this Amendment, claims 1, 2, 15 and 17-23 are amended, and claims 27 and 28 are added. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Information Disclosure Citation

Applicants thank the Examiner for considering the references supplied with the Information Disclosure Statement filed on September 29, 2006, and for providing Applicants with an initialed copy of the PTO/SB/08 form filed therewith.

Drawings

Applicants acknowledge with appreciation the indication by the Examiner that the drawings filed on March 2, 2007 are accepted.

Rejection Under 35 U.S.C. § 102

Claims 1-6, 9, 11-15 and 17-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by WO 2002/068952 to Hayashizaki et al. (Hayashizaki '952"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. *See In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *In re Gulag*, 62 USPQ2d 1151

(Fed. Cir. 2002).

Moreover, as stated in MPEP §707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). *See Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. *See Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference, *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Claim 1, as amended, recites a method of analyzing a biosample using laser ablation, comprising: irradiating ultra-short pulse laser beams on a biosample to be analyzed by moving the ultra-short pulse laser beams across plural different regions of the biosample area and ablating the sample to atomize molecules contained in different regions of said biosample into constituting elements and to ionize said atomized constituting elements, analyzing morphologically and compositionally said ionized constituting elements to determine element strength, and generating an image which simultaneously shows a morphological characteristic and element strength of the irradiated biosample.

Applicants Figs 22-24 clearly show the strength of labeled elements on section images of the regions (1 to 4) and the morphological characteristics of the biotissue section and the measurement results are recognized at the same time. as disclosed, for example, on page 38 of the Application, as filed.

Applicants respectfully submit that the combination of features recited in claim 1, as amended, is clearly not disclosed by Hayashizaki '952.

Because claims 2-6, 9, 11-15 and 17-18 depend from claim 1, these claims are allowable at least because of the features of claim 1 that are contained therein.

Accordingly, reconsideration and allowance of claims 1-6, 9, 11-15 and 17-18 are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 7 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 2004-0115665 to Hayashizaki et al. (Hayashizaki '665"). Claim 8 stands rejected under 35 USC §103(a) as being unpatentable over Hayashizaki '952 in view of Hayashizaki '665 and further in view of U.S. Patent Application Publication 2003/0215457 to de Sauvage et al. ("de Sauvage"). Claim 16 stands rejected under 35 USC §103(a) as being unpatentable over Hayashizaki '952 in view of U.S. Patent 6,680,477 to Beck et al. ("Beck"). Claims 19 and 24-26 stand rejected under 35 USC §103(a) as being unpatentable over Hayashizaki '952 in view of Beck. These rejections are respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is

not being repeated here.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole, "not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention *as a whole* would have been obvious to a person of ordinary skill in the art at the time the invention was made. See *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. See *Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert.*

denied, 488 U.S. 825 (1988); *Ashland Oil, Inc. v Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *See In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *See C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *See In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on

objective evidence of record, not merely conclusory statements of the Examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness:" *In re Kahn*, 441 F.3d 977,988(Fed. Cir. 2006) (quoted with approval in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

In the sentence just prior to citing the *Kahn* case, the U.S. Supreme Court clearly stated that there has to be an apparent reason to combine the known elements in the manner claimed. The Office has the burden of making out a *prima facie* case of obviousness, i.e., by presenting objective factual evidence of a reason to combine the known elements in the manner claimed. The *KSR* decision did not lift that burden from the Office.

The articulated reasoning has to express a rationale explaining what would have led an ordinarily skilled artisan to combine selected features from each reference in a way that would have resulted in the claimed invention. *See, KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007). Thus, the Supreme Court reaffirmed the fundamental principles set forth in the *Graham v. John Deere Co.* decision, cited and discussed above.

With respect to claims 7-10 and 16, all of which depend from claim 1, Applicants respectfully submit that claim 1, as amended, is clearly not disclosed by Hayashizaki '952. Moreover, none of the secondary references applied in the rejection of claims 7-10 and 16 is applied to remedy the shortcomings of Hayashizaki '952 with respect to the claimed invention. Accordingly, even if, solely for sake of argument, one of ordinary skill in the art were properly motivated to modify Hayashizaki in view of the various secondary references, as suggested in the outstanding Office Action, the so- modified version of Hayashizaki would still not disclose, suggest, or otherwise render obvious the claimed invention.

With respect to claim 19 and claims 24-26 (to the extent that they depend from claim 19), Applicants have amended claim 19 to recite an analyzing apparatus of a biosample using laser ablation, comprising: an ultra-short pulse laser generating unit adapted to output ultra-short pulse laser beams to irradiate plural different regions of a biosample to be analyzed and to atomize molecules contained in said biosample into constituting elements, to ionize said atomized constituting elements; a spectrometer that introduces and compositionally analyzes the constituting elements that are ionized by the ultra-short pulse laser beams outputted from said ultra-short pulse laser generating unit; a microscope unit for observing the shape of said biosample to be analyzed; and an image generating device to generate an image which simultaneously shows a morphological characteristic and element strength of the irradiated biosample.

Clearly, Hayashizaki '952 does not disclose or suggest the subject matter recited in claim 19. Moreover, because claims 24-26 contain the subject matter of claim 19, Hayashizaki does not

disclose or suggest the subject matter of claims 24-26.

Accordingly, reconsideration and withdrawal of these rejections under 35 USC §103 are respectfully requested.

Allowable Subject Matter

The Examiner states that claims 20-23 would be allowable if rewritten in independent form.

Applicant thanks the Examiner for the early indication of allowable subject matter in this application. Objected-to claim 20-23 have been rewritten into independent form, and should therefore be allowed. Also, to the extent that claims 24-26 depend from claims 20-23, claims 24-26 are therefore allowable.

Claims 27-28

Claims 27-28 have been added for the Examiner's consideration. Applicants submit that claim 27 depends from independent claim 1, and claim 28 depends from claim 19, and claims 27-28 are therefore allowable based on their dependence from either claim 1 or claim 19, which are believed to be allowable for reasons presented above.

In addition, claims 27-28 recite further features which are not disclosed or made obvious by the applied prior art references.

Consideration and allowance of claims 27-28 are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: **MAR 31 2010**

Respectfully submitted,

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